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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,466	08/07/2003	Alejandro Wiechers	200207444-1	7655

22879 7590 07/03/2007
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EXAMINER

RODRIGUEZ, LENNIN R

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,466

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

Lennin R. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/07/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Other Documents section in the information disclosure statement filed 8/07/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the articles provided does not contain or have an accessible way to determined the articles' date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification

2. The abstract of the disclosure is objected to because it contains improper language such as:

(1) "comprises" used in line 3.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A "program product" is being recited; however a "program product" as presented in the claims is directed to software per se. This subject matter is not limited to that which falls within a statutory category of invention because it is limited to a process, machine, manufacture, or a composition of matter. Software is a function descriptive material and a function descriptive material is non-statutory subject matter. Examiner suggest changing it to – program product stored in a computer readable medium --.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kemp et al. (US Publication 2002/0078160).

(1) regarding claim 1:

Kemp '160 discloses a method of managing workflow in a commercial printing environment including a designer location and a print service provider location (Fig. 1 where the home client is the designer location), said method comprising:

creating a press ready file at the designer location using updated device configuration information from the print service provider location (paragraph [0036], where the client or home user is the designer location, and it offers the ability to create documents using device configuration information (the device configuration information at some point in time has to be updated into the system));

submitting said press ready file to the print service provider location via an electronic network (paragraph [0053], lines 5-11, where the user submits the job to the provider);

verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location (paragraph [0084], lines 1-8, where the service provider makes sure the job is printed as designed by the user) and, if not, correcting said press ready file to ensure printing substantially as designed (paragraph [0084], lines 26-29, where if the job cannot be completed as designed the user has the option to make corrections); and

performing automated finishing using, if created, said corrected press ready file, else using said verified press ready file (paragraph [0040] and paragraph [0041], where the service provider may include equipment for doing finishing options).

(2) regarding claim 2:

Kemp '160 further discloses wherein said step of creating a press ready file at the designer location further comprises performing automated remote finishing setup of said press ready file to remotely select the desired finishing options for said press ready file when printed at said print service provider location (paragraph [0041], lines 4-9,

where the user remotely (from the designer location) can add finishing instructions to be performed at the service provider location).

(3) regarding claim 3:

Kemp '160 further discloses wherein said step of verifying, at said print service provider location, further comprises performing automated remote finishing setup (paragraph [0068], paragraph [0069] and paragraph [0073], where upon receiving the print data the service provider is setup automatically to process the print job).

(4) regarding claim 4:

Kemp '160 further discloses wherein said step of automated finishing is performed and wherein an automated finishing device is used to finish said printed output in accordance with finishing instructions in said press ready file (paragraph [0041], lines 4-9, where the finishing device is the finishing equipment and when it says that the necessary equipment for performing the finishing request is being interpreted as being in accordance with the finishing instructions I the press ready file).

(5) regarding claim 5:

Kemp '160 further discloses wherein said step of correcting includes reading finishing instructions prepared at the designer location (paragraph [0067] and paragraph [0068], where the designer location is the end user section and the instructions are being read by the print driver) and preparing appropriate corresponding instructions for an actual finishing device to be used at the print service provider location (paragraph [0067], where the user request (prepare) special request instructions (finishing instructions) to be used at the service provider location).

(6) regarding claim 6:

Kemp '160 further discloses wherein said step of correcting further comprising updating a job ticket corresponding to said press ready file (paragraph [0084], where after an error message generated by the service provider the user can submit a new request with new information contained in it, therefore updating the job ticket).

(7) regarding claims 7 and 23:

Kemp '160 further discloses a system for performing automated finishing in a commercial printing environment including a designer location and a print service provider location (Fig.1 and Fig. 5), said system comprising:

means for creating a production ready file at the designer location using updated device configuration information from the print service provider location (paragraph [0036], where the client or home user is the designer location, and it offers the ability to create documents using device configuration information (the device configuration information at some point in time has to be updated into the system)), said production ready file including finishing instructions (paragraph [0067], where the production ready file can include special instructions such as finishing instructions);

means for submitting said production ready file to the print service provider location via an electronic network (paragraph [0053], lines 5-11, where the user submits the job to the provider); and

means for receiving a printed output of said production ready file (paragraph [0041], lines 4-7, where print job is being interpreted as a printed document) and finishing said printed output at a finishing device in accordance with finishing

instructions from said production ready file (paragraph [0041], lines 4-7, where the service provider may include equipment for doing finishing options).

(8) regarding claims 8 and 16:

Kemp '160 further discloses wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said production ready file will be produced at said print service provider location as designed at the designer location (paragraph [0084], lines 1-8, where the service provider makes sure the job is printed as designed by the user) and, if not, correcting said production ready file, including said finishing instructions, to ensure production substantially as designed (paragraph [0084], lines 26-29, where if the job cannot be completed as designed the user has the option to make corrections).

(9) regarding claims 9 and 17:

Kemp '160 further discloses wherein said step of correcting further comprises reading finishing instructions prepared at the designer location (paragraph [0067] and paragraph [0068], where the designer location is the end user section and the instructions are being read by the print driver) and preparing appropriate corresponding instructions for an actual finishing device to be used at the print service provider location (paragraph [0067], where the user request (prepare) special request instructions (finishing instructions) to be used at the service provider location).

(10) regarding claims 10 and 18:

Kemp '160 further discloses wherein said step of correcting further comprises adding finishing instructions for an actual finishing device to be used at the print service

provider location to supplement finishing instructions prepared at the designer location (paragraph [0084], lines 26-29, and paragraph [0085], lines 4-7, where the user re-submits a print job with new information is being interpreted as adding finishing instructions prepared at the designer location (client)).

(11) regarding claims 11 and 19:

Kemp '160 further discloses wherein said method further comprises sending an indication of the operational status of the finishing device to a server computer at said print service provider location (paragraph [0041], lines 4-9, where the service provider makes a determination as to whether it can perform the finishing request, thus suggesting that an indication of the finishing device operational status is being received).

(12) regarding claims 12 and 20:

Kemp '160 further discloses wherein said method further comprises sending an indication of the job completion status of the finishing device to a server computer at said print service provider location (paragraph [0066]).

(13) regarding claims 13 and 21:

Kemp '160 further discloses wherein said step of correcting further comprising updating a job ticket corresponding to said production ready file (paragraph [0084], where after an error message generated by the service provider the user can submit a new request with new information contained in it, therefore updating the job ticket).

(14) regarding claims 14 and 22:

Kemp '160 further discloses wherein said step of creating a production ready file at the designer location using updated device configuration information from the print service provider location further comprises selecting an available finishing device based on said updated device configuration information (paragraph [0085], lines 1-4, where if the server determines that the print shop is capable of performing the finishing instructions request is a clear determination that is selecting an available device).

(15) regarding claim 15:

A program product (paragraph [0048], where the instructions necessary for implementing the invention can be implemented in software) for performing automated finishing in a commercial printing environment including a designer location and a print service provider location (Fig. 1 and Fig. 5), said product comprising machine-readable program code (paragraph [0048]) for causing, when executed, a machine to perform the following method steps:

creating a production ready file at the designer location using updated device configuration information from the print service provider location (paragraph [0036], where the client or home user is the designer location, and it offers the ability to create documents using device configuration information (the device configuration information at some point in time has to be updated into the system)), said production ready file including finishing instructions (paragraph [0067], where the production ready file can include special instructions such as finishing instructions);

submitting said production ready file to the print service provider location via an electronic network (paragraph [0053], lines 5-11, where the user submits the job to the provider); and

receiving a printed output of said production ready file (paragraph [0041], lines 4-7, where print job is being interpreted as a printed document) and finishing said printed output at a finishing device in accordance with finishing instructions from said production ready file (paragraph [0041], lines 4-7, where the service provider may include equipment for doing finishing options.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application

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No. 10/635452. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 in the present application are directed towards performing automated finishing, whereas claims 1-6 of the referenced copending application are directed towards performing automated packaging. It appears to the examiner that these limitations (finishing view of packaging) are obvious variations of each other since documents needs to be finished before they can be package.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of '530 application since packaging could reasonable be interpreted as part of a finishing process. The finishing instructions are an obvious predecessor to the packaging instructions.

9. Claims 7-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/635437. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-23 in the present application are directed towards performing automated finishing, whereas claims 1-17 of the referenced copending application are directed towards performing automated packaging. It appears to the examiner that these limitations (finishing view of packaging) are obvious variations of each other since documents needs to be finished before they can be package.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of '530 application since packaging could reasonable be interpreted as part of a finishing process. The finishing instructions are an obvious predecessor to the packaging instructions.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hansen et al. (US Patent 6,407,820) disclose a system and method for managing production workflow. Steward et al. (US Patent 6,714,964) discloses a system, method and recordable medium for receiving and transmitting data over a network, and in particular, to receiving and transmitting print data from a print spooler via a port monitor and upload manager to a web server.

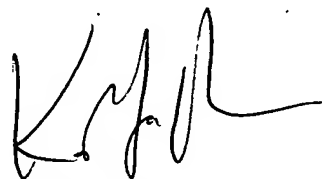
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lennin R. Rodriguez whose telephone number is (571) 270-1678. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung S. Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lennin Rodriguez
6/24/07



KING Y. POON
PRIMARY EXAMINER